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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/611,690

06/30/2003

Christopher Budd

13768.385

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EXAMINER

FISHER, PAUL R

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/611,690	<b>Applicant(s)</b> BUDD ET AL.	
	<b>Examiner</b> PAUL R. FISHER	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This communication is a first Office Action Non-Final rejection on the merits.

Claims 1-63, as originally filed, are currently pending and have been considered below.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-63 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In independent claims 1, 22, 26, 48 and 60, the claimed steps of an act of identifying steps, act of identifying a corresponding team of one or more people responsible for proper implementation, an act of providing a user interface and an act of causing notification are not properly described in a way in which to enable one of ordinary skill in the art to be able to use the invention. It is unclear who is performing these steps and if it is a computer how the computer is performing these steps. It is unclear how to have a pervious or subsequent step with out a first step. It is unclear what structure or information is needed to identify a course of steps that will advance a goal and to what degree it must be advanced. It is also unclear as to who is identifying those responsible for the steps and what is done in the act of identifying, or how they became responsible for those steps.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The follow are examples of some of the 112, second paragraph rejections, and are not to be considered an exhaustive set, since the claims require the applicant to correct numerous issues.

In claims 1, 22, 26, 48, 60 and 61, it is unclear to the Examiner what the applicant has claimed. It is unclear to what structure is involved in an act of identifying a course of steps and if this process is done by the computer or by some system administrator. It is further unclear to the Examiner how to identify these steps and how far they need to be to advance the goal.

Further it is unclear what is being done in the act of identifying a corresponding team of one or more people responsible, are you assigning the various steps to different team or merely just making note of which teams are already responsible? If they are already responsible how and when did that take place? Further how can there be a previous step or subsequent step when no step has occurred yet?

It is also unclear who or what is performing an act of providing a first user interface or what the interface is? If this is web interface what is providing this web site is it a web server?

Who is performing the act of causing at least a representative? What is involved in this act?

In claims 2 and 28, the claim is indefinite in that it states the steps can be done or rather are done in parallel but in the independent claims 1 and 26 the steps were done in series. That the first step was completed by the first time and only then is a notification sent to the second team and only then are they allowed access to their interface which allows them to complete their step. How can it be done in series and in parallel?

In claims 3, 29 and 53, it is unclear to the Examiner if this is a new representative from a new team or merely a representative from one of the existing teams and how this is different from the independent claim where the second team is notified of the completion of the first or previous step. Also this new third interface is it corresponding to a new team or is part of the interface of one of the existing teams? Further it is unclear how the subsequent step can be broken down into multiple steps and how they can be done in parallel.

In claims 4-7 and 30-33, it is unclear to the Examiner how the subsequent step can correspond to any team but the second team since in the independent claim it is claimed as such, at which point how do these claims further limit the invention?

In claims 8, 34, and 54, it is unclear to the Examiner if this is a new representative from a new team or merely a representative from one of the existing teams and how this is different from the independent claim where the second team is notified of the completion of the first or previous step. Also this new third interface is it

corresponding to a new team or is part of the interface of one of the existing teams?

Further it is unclear how the previous step can be broken down into multiple steps and how they can be done in parallel.

In claims 9-12 and 35-38, it is unclear to the Examiner how the previous step can correspond to any team but the first team since in the independent claim it is claimed as such, at which point how do these claims further limit the invention?

In claim 14, 40 and 56, it is unclear to the Examiner how some, but not all of any team can be notified since the independent claim states that teams can comprise one person? How is it possible to notify some of one person but not all of one person?

Claim 19 recites the limitation "the product" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation "the software performance deviation" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-21, 26-47 and 60-63 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or

materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 1-21, 26-47 and 60-63 are non-statutory since they may be preformed within the human mind; the steps of identifying, providing and causing notification are not done by a computer.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-63 rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Bugzilla: [http:// web.archive.org/web/20020202141951/bugzilla.org/about.html](http://web.archive.org/web/20020202141951/bugzilla.org/about.html)**

**(Feb. 2, 2002) hereafter Bugzilla.**

As best understood by the Examiner claims 1-63 are interpreted in the following way:

**As per claims 1-63**, Bugzilla discloses a method and computer readable medium which is used over a computer network which assists in the inter-team cooperation for accomplishing a collaborative goal which is to generate corrective software for software bugs (Page 1, paragraph 1; discloses that Bugzilla is an example of a class of computer programs called "Defect Tracking Systems", or more commonly "Bug-Tracking Systems". Defect Tracking Systems allow individual or groups of developers to keep track of outstanding bugs in their product effectively, thus this system works over a network to assist groups or teams of developers in accomplishing their goal of fixing software bugs in their products);

identifying steps that will advance development of the software fix, the steps requiring the cooperation of teams (While Bugzilla doesn't explicitly disclose the system identifying steps that need to be completed in order to fix a bug it would have been obvious to one having ordinary skill in the art of computer software corrections that steps would need to be identified in order for them to be carried out by the users. Pages 33-41; disclose the Administrations job from a top down approach the Product or computer program is broken down into components which are could all have possible bugs, these bugs would have to be identified, then each step could correspond to fixing a particular bug in a particular component of the over all computer product, so in this example say there were software problems in your "UI", "API", "Sound System" components then the steps would be to correct bugs in the various components and each group or team



would be assigned a particular component as disclosed on Page 34, paragraphs 1 and 2 specifically. It could also be that there were multiple bugs in a single component and there are multiple teams that work in that individual component);

assigning responsibility to a team for each step; where each step corresponds to an associated team (Page 34, paragraphs 1 and 2; disclose that each component or piece of the over all product can be divided into groups and the software fixes for bugs in those components could also be designed in the same groups, if the step were to correspond to fixing a particular bug in a particular component then it would be assigned to the group or team which is assigned to that component. Page 38; discloses that the administrator could also assign responsibility to each team for a product individually for example if it was a security risk you could assign various parts of the project to different people which would all have to work on their individual parts in order to fix the security bug);

providing an user interface to each team, in which they can complete their assigned steps, either after another team has finished or in parallel with another team (Page 14, Create a Bugzilla Account; discloses that each user creates their own portal into the system through the creation of an account, through this they will be able to receive email alerts and other information and the projects they are assigned to. Page 25, bullet 6; discloses that the system can perform bug corrects either in parallel or in series, for example if two people are working on the same file but different bugs the system performs a lockout meaning that only that person can access the file, this would be the series example, on the other hand the system can create a shadow database

where the other user or users can work, although only one user will have write access at a time);

automatically notifying users upon completion of a step, through the use of email which is considered to be a network address (Page 21, paragraph 3; discloses the user can set up their account so that every time the status on a particular bug is fixed they would be notified via email about the change, further it states that from a quality assurance stand point the could wait till a particular team finishes their work and notify via email the quality assurance people to inspect their work, from this example it is shown that the first team completes their assigned tasks and then and only then the second team can complete their task of inspecting if that was the assigned step);

detecting a software performance deviation (software bug) in the product (Page 18, writing a great bug report; disclose that they system can detect a software performance deviation or software bug);

wherein the computer-readable media are physical media, which is system memory which is a persistent (non-volatile) memory (Page 24; discloses that this program is to be used on a computer system and needs to be downloaded and installed onto a computer which would be installed on a Hard Drive which is considered to be system memory and a persistent (non-volatile) memory);

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the identifying steps to assign tasks to the different teams because it assists in the organization of the over all system and with out steps

the different team will not know how to manage the teams coordination and collaboration.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL R. FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [7:30am/5pm] with first Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PRF  
/Janice A. Mooneyham/  
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